

Applicant: Fredrik Nilsson
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REMARKS

Restriction Requirement

In the Office Action, the Examiner required restriction of pending claims 1-37, 40-43, 45-46 and 48-49 to one of the following ten allegedly distinct inventions under 35 U.S.C. §121:

- I. Claims 30-33 and 36, drawn to an array;
- II. Claims 45-46, drawn to a data carrier;
- III. Claim 37, drawn to an apparatus;
- IV. Claims 40-41 and 43, drawn to a library of binding molecules;
- V. Claims 1-27, drawn to a method for analyzing a heterogeneous sample of proteins or peptides;
- VI. Claims 28-29, drawn to a method of identifying disease-related proteins;
- VII. Claims 34-35, drawn to a method of making an array;
- VIII. Claim 42, drawn to a method of making a library of binding molecules comprising combining a selector peptide and binding molecules and identifying the binding molecules;

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IX. Claim 49, drawn to a method of making a library comprising providing a selector peptide and binding molecules, combining a selector peptide and the binding molecules, identifying the binding molecules that bind a selector peptide, immobilizing the binding molecules on an array, providing a sample of heterogeneous proteins, and separating and characterizing the proteins; and

X. Claim 48, drawn to a method of administering a pharmaceutical agent specific to a diseased individual, classified in class 424, subclass 130.1, for example.

The Examiner also required election of allegedly patentably distinct Markush groups and/or species of the claimed inventions for Groups I-X.

In response, applicant hereby elects Group V, i.e., claims 1-27, with traverse, for prosecution at this time. Applicant also elects, with traverse, the following species of Group V:

- A. "antibody", as a species of binding molecules;
- B. "at least about 10 different types of binding molecules", as a species of number of binding molecules;
- C. "a C-terminal motif of four amino acids which comprises a C-terminal arginine or lysine and three additional variable amino acids", as a species of motif;

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- D. "at least 10%", as a species of capture;
- E. "containing plasma proteins", as a species of heterogeneous sample;
- F. "trypsin digestion", as a species of fragmenting;
- G. "desorption mass spectroscopy", as a species of characterizing; and
- H. "collision induced mass spectrometry", as a species of identifying.

Applicant, however, respectfully requests that the Examiner reconsider and withdraw the restriction requirement. Pursuant to M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. Applicant respectfully submits that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Groups I-IV and VI-X would not impose a serious burden once the prior art relevant to Group V has been identified. Therefore, applicant requests that the claims of Groups I-X be examined together in the subject application.

Regarding the selection of species within Group V, applicant notes that each type of binding molecule will bind to only one type of motif, notwithstanding that the different types of binding molecules on any array will have different binding specificities with regard to the motif of the proteins to be

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bound. In view of the election of "antibody" as a species of binding molecules, applicant requests that the Examiner reconsider and withdraw the requirement for election of a species of motif.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone her at the number provided below.

Please charge the required fee of ONE THOUSAND, FIVE HUNDRED AND NINETY DOLLARS (\$1,590.00) for a four-month extension of time to the deposit account of Kenyon & Kenyon, deposit account number 11-0600. No other fee is deemed necessary in connection with the filing of this Communication. However, if an additional fee is required, authorization is hereby given to charge the amount of any such fee to deposit account number 11-0600.

Respectfully submitted,
KENYON & KENYON, LLP

Carmella L. Stephens

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

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